

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

HOLOGIC, INC. and CYTYC SURGICAL
PRODUCTS, LLC,

Plaintiffs and
Counterdefendants,

V.

MINERVA SURGICAL, INC.,

Defendant and
Counterclaimant.

C.A. No. 15-1031-JFB-SRF

JURY TRIAL DEMANDED

REDACTED PUBLIC VERSION

**DEFENDANT MINERVA SURGICAL, INC.’S REPLY IN SUPPORT OF ITS
MOTION *IN LIMINE* NO. 1: TO EXCLUDE IMPROPER WILLFULNESS EVIDENCE**

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Dated: July 6, 2018

Minerva's Motion *in Limine* No. 1 should be granted.

First, Hologic fails to (and cannot) rebut that the PTX-0042 email is irrelevant or highly prejudicial. Contrary to Hologic's argument, the email is not "directly on point" to any of the issues left for jury trial, including willful infringement. Hologic's attempt to split hairs and to distinguish Minerva's cited cases as relating to 510(k) or ANDA is baseless. The reasoning as to why such evidence is inadmissible and irrelevant is the same—the FDA equivalence involves fundamentally different inquiries than patent law.

Second, Hologic cannot dispute that there is no live witness (or deposition witness) that can lay any foundation for the third-party statement in the PTX-0058 email. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] D.I. 432, Ex. 1 at 113:1-2, 113:5-114:14. Dr. Skalnyi also was not a recipient of the email sent by the third-party doctor as shown on the face of the email and similarly cannot lay any foundation to the third-party statement at issue.

Third, Minerva is not the party who is trying to introduce the concept of advice of counsel with regards to the accused product. It is Hologic. Indeed, Minerva filed this motion to **exclude** the PTX-0058 email. Thus, Hologic's argument that Minerva is trying to use advice of counsel as a shield and a sword is nonsense. Further, Mr. Magen's opinion of counsel has nothing to do with the accused product, but only relates to a non-infringing alternative relevant to damages issues.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I, Benjamin J. Schladweiler, hereby certify that on July 6, 2018, I caused the foregoing *Defendant Minerva Surgical, Inc.'s Reply in Support of Motion In Limine No. 1: to Exclude Improper Willfulness Evidence* to be served via electronic mail upon the following counsel of record:

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